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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,305	02/15/2002	Albert Eugster	GR-47	3405

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Friedrich Kueffner
317 Madison Avenue
Suite 910
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EXAMINER

DEUBLE, MARK A

ART UNIT	PAPER NUMBER
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3651

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/077,305

Applicant(s)

EUGSTER ET AL.

Examiner

Mark A. Deuble

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

The applicant has mentioned European Patent document 0 380 921 B1 in several places in the specification. However, mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). Furthermore, an incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 3, 5 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not enable the adjustable plate configured to be liftable of claim 3, the yielding roller cover on at least one of the roller path and the drive roller of claim 5, or the spacing between the at least two opposed adjustable plate of the compartment in the closed position of claim 9 because the specification makes no mention of these features and describes no means for achieving these features.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5 and 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 states that at least one of the roller path and the drive roller has a yielding roller cover. This renders the scope of the claim impossible to ascertain because it is not understood how a yielding roller cover can be on the roller path instead of the roller.

Claim 8 recites the limitation "the roller path" in line 2. There is insufficient antecedent basis for this limitation in the claim. It appears that the dependency of the claim should be changed from claim 1 to claim 4 in order to provide proper antecedent basis for the claim term.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boss.

Boss shows a conveying arrangement for processing printed material on a conveying member 42 supplying printed material to an intermediate conveying device 9 which in turn supplies printed material to a synchronously operated feeder 1 arranged downstream of the intermediate conveying device. The intermediate conveying device has a plurality of compartments 4 formed by two plates 16 and 14 that are adjustable relative to each other and that are rotating about an axis of rotation 10. In operation, the compartments are moved into an open position for receiving printed material when approaching the conveying member and then into a closed position for further transporting the received printed material. Because the plate member 16 moves upward relative to the to the plate member 14, it may be considered to be liftable when that word is given its broadest reasonable interpretation. Conveying means formed by rollers 22 and 34 are arranged opposite one another on the two opposed adjustable plates so that they may transport frictionally the printed material clamped between the rollers out of the compartment. While the plates do not have through openings of the type shown in Fig. 2 of the present

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application, it is clear that the rollers 34 and 22 project from openings formed in the ends of members 16 and 14 as may be seen in Fig. 2 of Boss. A drive configured to act on the conveying means if formed by a stationary roller path 28 and a drive roller 30a connected to the rollers 22 through linkage 32-33 so that the rollers 22 eject the printed material when the drive roller 30a is acted upon by the roller path. Thus Boss shows all the structure required by claims 1-5 except for the pocket shaped receiving elements on the synchronously operating feeder required by claim 1 and for the yielding roller cover of claim 5.

It should be noted, however, this the use of pocket shaped receiving elements in place of the saddle shaped receiving elements for receiving printed material from an intermediate conveying device of the type shown in Boss is well known in the art as is evidenced by European document numbers 0 380 921 B1 and A2 and by Merwarth et al. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to replace the saddle shaped receiving elements of Boss with pocket shaped receiving elements.

Furthermore, the use of cam roller having an elastic or yieldable surface to prevent slippage between the cam roller and the cam surface is also well known in the art and therefore is deemed to have been an obvious design choice absent some disclosure in the applicant's specification of some unusual advantage or result. *In re Kuhle*, 188 USPQ 7 (CCPA 1975).

9. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosslinghoff (U.S. Patent No. 5,556,087).

Gosslinghoff shows a conveying arrangement for processing printed material on a conveying member 70 supplying printed material to an intermediate conveying device 10 which in turn supplies printed material to a synchronously operated feeder (not shown) arranged

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downstream of the intermediate conveying device. The intermediate conveying device has a plurality of compartments formed by two plates 36 and 18 that are adjustable relative to each other and that are rotating about an axis of rotation 12. In operation, the compartments are moved into an open position for receiving printed material when approaching the conveying member and then into a closed position for further transporting the received printed material. Because the plate member 36 moves upward relative to the to the plate member 18, it may be considered to be liftable when that word is given its broadest reasonable interpretation.

Conveying means formed by rollers 30 and 32 are arranged opposite one another on the two opposed adjustable plates so that they may transport frictionally the printed material clamped between the rollers out of the compartment. While the plates do not have through openings of the type shown in Fig. 2, the device of Gosslinghoff is functionally equivalent with such a device because only the rollers clamp the printer material therebetween. A drive (not shown) configured to act on the conveying means 30 to eject the printed material into the downstream conveyor. Thus Gosslinghoff shows all the structure required by claims 1-3 except for the pocket shaped receiving elements on the synchronously operating feeder required by claim 1.

It should be noted, however, this the use of pocket shaped receiving elements in place of the saddle shaped receiving elements for receiving printed material from an intermediate conveying device of the type shows in Gosslinghoff is well known in the art as is evidenced by European document numbers 0 380 921 B1 and A2 and by Merwarth et al. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to replace the saddle shaped receiving elements of Boss with pocket shaper receiving elements.

Allowable Subject Matter

10. Claims 6-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

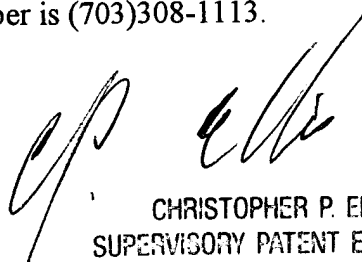
Weber, Schlough, and Curley et al. both show intermediate conveying devices which employ rollers to eject printed material therefrom.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Deuble whose telephone number is (703) 305-9734.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher P Ellis can be reached on (703) 308-2560. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 308-0552 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

md
June 20, 2003


CHRISTOPHER P. ELLIS
SUPERVISORY PATENT EXAMINER
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